

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35

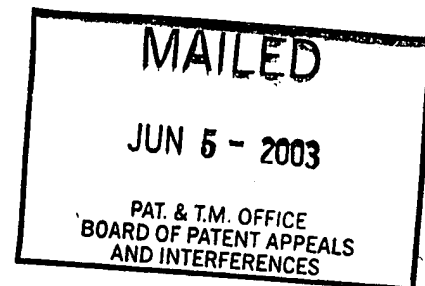
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUNICHI SATO

Appeal No. 2003-0467
Application No. 09/161,520

ON BRIEF



Before GARRIS, PAK, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

REMAND TO THE EXAMINER

This appeal was scheduled for an oral hearing to be held on May 20, 2003 (Paper No. 33). Prior to the scheduled hearing, however, it was determined that the application is not ready for a decision on the merits and that a remand would be appropriate. On May 19, 2003, the appellant's representative was informed by telephone that the scheduled hearing was being vacated and that a remand will follow. The appellant's representative

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appropriately did not appear for the oral hearing. Accordingly, the oral hearing set for May 20, 2003 has been vacated.

Pursuant to 37 CFR § 1.196(a)(1989), we remand this application to the examiner for further action and consideration not inconsistent with our opinion below.

In the answer mailed Sep. 26, 2002 (paper 28), the examiner maintained various grounds of rejection including a rejection of appealed claims 14, 20, 22, and 24-27 under 35 U.S.C. § 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention."

(Pages 6-7). Belatedly, the appellant submitted new evidence in the form of exhibits attached to a paper captioned "Reply Brief." ("Reply Brief" filed Nov. 26, 2002, paper 30.)

Concerning the appellant's submission, the examiner stated: "The reply brief filed November 26, 2002 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal."

(Communication mailed Jan. 6, 2003, paper 32.) The examiner, however, did not comment on the newly submitted evidence, i.e. the attached exhibits.

37 CFR § 1.195 states: "Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented." In addition, MPEP § 1208.03 (Aug. 2001) explains:

Amendments, affidavits, and/or other evidence must be submitted in papers separate from the reply brief, and the entry of such papers is subject to the provisions of 37 CFR 1.116 and 37 CFR 1.195. A paper that contains an amendment (or evidence) is not a reply brief within the meaning of 37 CFR 1.193(b). Such a paper will not be entitled to entry simply because it is characterized as a reply brief.

It is clear, therefore, that the examiner's failure to comment on the newly submitted evidence is not in accordance with current patent practice and procedure. To correct the ambiguity in the record, we authorize the examiner to prepare a supplemental examiner's answer pursuant to 37 CFR § 1.193(b)(1) (2000) {clarifying whether the submission of the exhibits attached to the appellant's "Reply Brief" complies with the provisions of 37 CFR § 1.195¹⁰ and, if so, clearly indicating whether these exhibits have been entered and considered. If necessary, we authorize the examiner to supply a response to the arguments set forth in the reply brief.

This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D) (8th ed.,

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Rev. 1, Feb. 2003). Thus, it is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED



Bradley R. Garris
Administrative Patent Judge



Chung K. Pak
Administrative Patent Judge



Romulo H. Delmendo
Administrative Patent Judge

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